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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,991	02/09/2004	Ching-Chiang Yu	MR2349-1351	1285

4586 7590 03/21/2007
ROSENBERG, KLEIN & LEE
3458 ELLICOTT CENTER DRIVE-SUITE 101
ELLICOTT CITY, MD 21043

EXAMINER

SEMBER, THOMAS M

ART UNIT	PAPER NUMBER
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2885

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/775,991

Applicant(s)

YU ET AL.

Examiner

Thomas M. Sember

Art Unit

2885

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,8,12,13,15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8,12,13,15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 5-6, 8, 12-13, 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Rohne et al '773. Rohne et al '773 discloses a keyboard comprising a plurality of key caps (24 in figure 2) having a layer of fluorescent ink (16, column 3, lines 54-55) thereon, said fluorescent ink **forming symbols (18) by negative plate printing on said key caps (see note 1)**, said key caps being illuminated by emission of light from said fluorescent ink ***responsive to impingement thereon by a light emission from a computer monitor (see note 2).***

Note 1: the text in regular bold is a product by process claim and therefore the process of making the product is not given patentable weight. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Applicant does this throughout the claims, for example, in claim 5, line 2 applicant claims “printed symbols are formed by negative plate printing using normal ink” is a product by process claim.

Note 2: the test in bold italic, is an intended use process and given very little patentable weight, since the fluorescent ink is capable of being impinged by light emission from monitor it meets applicant's claimed invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 5-6, 8, 12-13, 15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Oross et al '368. Oross et al '368 discloses a keyboard comprising a plurality of key caps 134 having a layer of fluorescent ink (140 and 142) thereon, "said fluorescent ink **forming symbols by negative plate printing on said key caps (see note 1)**, said key caps being illuminated by emission of light from said fluorescent ink ***responsive to impingement thereon by a light emission from a computer monitor (see note 2).***"

Note 1: the text in regular bold is a product by process claim and therefore the process of making the product is not given patentable weight. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Applicant does this throughout the claims, for example, in claim 5, line 2 applicant claims "printed symbols are formed by negative plate printing using normal ink" is a product by process claim.

Note 2: the test in bold italic, is an intended use process and given very little patentable weight, since the fluorescent ink is capable of being impinged by light emission from monitor it meets applicant's claimed invention.

Response to Arguments

Applicant's arguments filed 12/14/06 have been fully considered but they are not persuasive. The applicant argues " Rohne does not disclose the benefits from directly negatively plate printing the fluorescent ink on to the key caps of the keyboard. It is respectfully submitted that the Rohne reference does not provide for: "... a layer of fluorescent ink thereon, the fluorescent ink forming symbols by negative plate printing on the key caps, the key caps being illuminated by emission of light from the fluorescent ink responsive to impingement thereon by a light emission from a computer monitor..." (emphasis added), as defined by newly amended independent Claims 1 and 8."

The examiner disagrees.

As broadly claimed the recitation of "said fluorescent ink **forming symbols (18) by negative plate printing on said key caps (see note 1)**, said key caps being illuminated by emission of light from said fluorescent ink ***responsive to impingement thereon by a light emission from a computer monitor (see note 2).***" is taught by the Rohne reference.

Note 1: the text in regular bold is a product by process claim and therefore the process of making the product is not given patentable weight. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Art Unit: 2885

Applicant does this throughout the claims, for example, in claim 5, line 2 applicant claims “printed symbols are formed by negative plate printing using normal ink” is a product by process claim.

Note 2: the test in bold italic, is an intended use process and given very little patentable weight, since the fluorescent ink is capable of being impinged by light emission from monitor it meets applicant’s claimed invention.

5. In response to applicant's argument that the Rohne device is not for use with computer monitor, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

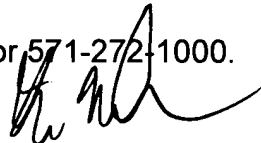
Art Unit: 2885

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Sember whose telephone number is 571-272-2381. The examiner can normally be reached on M-F 9 a.m.- 5.30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571-272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thomas M Sember
Primary Examiner
Art Unit 2885